

REMARKS

The last Office Action has been carefully considered.

It is noted that claims 1, 5-13 and 16-17 are rejected under 35 U.S.C. 103(a) over the patent to Schill in view of the patent to Zimmer.

Claims 14-15 are rejected under 35 U.S.C. 103 over the patent to Schill in view of the patent to Zimmer.

Also, the claims are rejected under 35 U.S.C. 112.

In connection with the Examiner's rejection of the claims under 35 U.S.C. 112, it is believed to be advisable to explain in detail the terms "positive engagement" and "non-positive engagement".

It is respectfully submitted that the term "positive engagement" is used for such a connection in which the parts engaged with one another are substantially immovable relative to one another because of their interlocking or interengagement with one another by their bodies having portions which are directly introduced into one another. The examples of

positive engagements are an engagement of an inner thread of a nut with outer thread of the bolt, an engagement of an inwardly splined surface of a disc with an outwardly splined surface of a shaft, an engagement of a rib extending from one part into a groove of another part, an engagement of an outer polygonal surface of a nut with an inner polygonal surface of a socket for turning the nut, etc.

In contrast, a non-positive engagement is an engagement in which the bodies of the parts to be engaged with one another do not interengage or interlock with one another, so that their portions do not extend into one another. The examples of non positive engagements are the engagement with a press fit of a ring having an inner circular surface on an outer circular surface of a shaft, the engagement of a conical axle in a conical opening of an axle carrier, the engagement of a plate having an inner opening provided with a chamfer on a pin having an outer chamfer, etc. While the parts which are non-positively engaged with one another transverse forces, they do not interlock with one another.

In accordance with the present invention as defined in the independent claims, the disc 36, 38 is in non positive engagement with the

axle 16, 18, and also, as now amended, the disc 36, 38 is in positive engagement with the steering lever 22, 24, 26.

Turning now to the references applied by the Examiner against the claims, it is respectfully submitted that the disc 12 disclosed in the patent to Zimmer is fitted on the hexagonal element 22 by its hexagonal shape, so that a form-locking or positive engagement is provided. During the mounting of the wiper arm 14, the disc 12, the wiper arm 14, the inner cone 16, as well as a screw nut must be placed on. This is relatively expensive.

In contrast, with the apparatus of the present invention in which there is a non-positive engagement between the disc and the axle, the window wiping device is supplied with the disc, so that a separate supply can be dispensed with. Moreover, the disc is mounted on the axle so that its loosening is prevented, and it can not be lost during transportation. Moreover, the disc, during the manufacture of the wiper device, is already correspondingly positioned and oriented. In this manner, the steering lever can be mounted at the vehicle manufacturer in a fast and exact fashion on the disc. With this feature, which admittedly can not be considered as huge redesigning of the window wiping device, numerous advantageous are

provided, which can not be accomplished by the constructions disclosed in the patent to Zimmer and Shill.

In connection with this, it is respectfully submitted that it is well known that a patentable invention does not necessarily have to be an immense breakthrough in a corresponding field of science and technology. Even small improvements can be very important and efficient, and can provide advantages which are very important for corresponding apparatuses, processes, materials, etc. It is believed that the present invention clearly belongs to this category of improvements which, while not related to the complete rearrangement of corresponding apparatuses, nevertheless is highly advantageous, unobvious, new and patentable over the art.

The references do not provide any hint or suggestion for the new features of the present invention, namely the non-positive engagement of the disc with the axle and the positive engagement of the disc with the steering lever, as defined in the independent claims. Moreover, they teach away from the applicant's invention.

In order to arrive at the applicant's invention from the references, the references have to be fundamentally modified, in particular

by changing the constructions disclosed in them to an opposite concept. However, it is known that in order to arrive at a claimed invention, by modifying the references the cited art must itself contain a suggestion for such a modification.

This principle has also been consistently upheld by the U.S. Court of Customs and Patent Appeals which, for example, held in its decision *in re Randol and Redford* (165 USPQ 586) that

Prior patents are references only for what they clearly disclose or suggest; it is not a proper use of a patent as a reference to modify its structure to one which prior art references do not suggest.

There are no hints or suggestions in the references for such modifications.

As explained herein above, the present invention provides for the highly advantageous results which can not be accomplished by the constructions disclosed in the references.

It is well known that in order to support a valid rejection the art must also suggest that it would accomplish applicant's results. This was

stated by the Patent Office Board of Appeals, in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

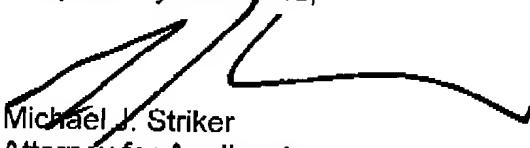
Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish applicants' result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices.

In view of the above presented remarks and amendments, it is believed that the independent claims currently on file should be considered as patentably distinguishing over the art and should be allowed.

Reconsideration and allowance of the present application is most respectfully requested.

Should the Examiner require or consider it advisable that the specification, claims and/or drawings be further amended or corrected in formal respects in order to place this case in condition for final allowance, then it is respectfully requested that such amendments or corrections be carried out by Examiner's Amendment, and the case be passed to issue. Alternatively, should the Examiner feel that a personal discussion might be helpful in advancing this case to allowance, he is invited to telephone the undersigned (at 631-549-4700).

Respectfully submitted,

  
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